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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,465	08/26/2003	Volkmar Voigtlander	41653-190642	2311

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EXAMINER

PETERSON, KENNETH E

ART UNIT PAPER NUMBER

3724

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/647,465	<b>Applicant(s)</b> VOIGTLANDER, VOLKMAR	
	<b>Examiner</b> Kenneth E. Peterson	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 5 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Paragraphs 00011 and 00027 state that the cutting edge surfaces that form a cutting edge are *asymmetrical*. Paragraphs 00027 and 00028 state that the cutting edge surfaces on a single plate are axially *symmetrical*. It is not clear what “axially” means. The drawings seem to show asymmetry. Given the confusing and contradictory language, it would not be clear how to make the device.

2. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not understood how to interpret Applicant's claims for symmetrical cutting edge surfaces and assymetrical cutting edge surfaces (see above rejection).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 3-8, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Jakobi '691, who shows in figure 3 a series of symmetric cutting edges formed by asymmetric cutting edge surfaces. Jakobi is capable of making cross-cuts, and thus his blades are considered to be cross cutters.

5. Claims 1-3 and 7-10, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Zysset '747, who shows in figures 2 and 3 a series of interconnected plates having symmetric cutting edges and plates (at least for the middle two) and having different "types" of plates (a short one at the end and a long one in the middle). Zysset is capable of making cross-cuts, and thus his blades are considered to be cross cutters.

6. Applicant's arguments have been fully considered but they are not persuasive.

Applicant's arguments with respect to the symmetrical/asymmetrical problem are confusing. Claim 5 seems to recite that "cutting edge surfaces....are arranged symmetrical to one another" and also "two asymmetrical cutting edge surfaces".

The term symmetry means "matching on both sides of a boundary". For the case of a single plate, it is assumed that the cutting edge is the boundary. Looking at Applicant's figure 3a, the cutting edge surfaces 31,32 on opposite side of the boundary

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are clearly assymetrical. Perhaps Examiner just doesn't understand what Applicant means by *axial* symmetry, since there is no clearly defined axis. Even if the cutting edge is considered to be the "axis", it still doesn't make any sense. What would be the boundary?

When Applicant says that the cutting edges (not cutting edge surfaces) are symmetrical, Examiner is assuming that the boundary is an imaginary plane halfway between adjacent plates.

Applicant argues against the Jakobi and Zysset rejections, by noting that the term "cross cutters" is employed. Applicant then attempts to import paragraphs 00010 and 00025 from the specification into the claims. However, Examiner is not authorized to make this importation. Many recent court decisions have affirmed that Examiners are to give terms their "broadest reasonable interpretation", see, for example, In re Morris, 127 F.3d 1048,1054-55 (1997). Furthermore, paragraphs such as 00029 make it clear that Applicant wishes the claims to be broader than the specification. See for example, Vanderlande Industries Nederland BV v. ITC, 366 F.3d 1333, 72 USPQ2d 1726 (2004).

The broadest reasonable interpretation of "cross cutter" would be a cutter that crosses something, such as a workpiece or a tool body. Indeed, this is how the term is commonly employed in industry.

Rather than trying importation, a better strategy for Applicant would be to amend the claims with the structural details that he believes to be distinguishing.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

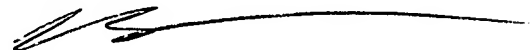
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Monday thru Thursday between 7:30am and 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached at 571-272-4514. In lieu of mailing, Applicants are encouraged to fax responses to 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. For more info on the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

kp

23-Jun-05



KENNETH E. PETERSON  
PRIMARY EXAMINER